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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Andrew DOWNIE et al.

Confirmation No.: 6184

Application No.: 10/798,201

Group Art Unit: 3672

Filing Date: March 10, 2004

Examiner: Andrea M. Valenti

For: DOWNHOLE TOOL

Attorney Docket No.: 85170-4599

**RESPONSE TO DECISION ON
PETITION FOR RETROACTIVE FOREIGN FILING LICENSE
UNDER 37 C.F.R. § 5.25 and § 5.13**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This response is filed in reply to the Patent Office communication dated November 25, 2005, which denied Applicants' petition for a retroactive foreign filing license. The basis for the denial was that the verified statement of Dr. Moreland fails to contain the statement that "the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order."

Applicants now submit a substitute declaration of Dr. Moreland in accordance with 37 C.F.R. § 5.25(a)(3) which now contains the previously omitted language. Thus, applicants again request a retroactive foreign filing license for U.K. Application No. GB 0101014.9, filed January 15, 2001 and PCT Application No. PCT/GB02/00178, filed January 15, 2002.

No fee is believed to be due for this response. Should any fees be required, please charge such fees to Winston & Strawn LLP Deposit Account No. 50-1814.

Respectfully submitted,

1/5/06
Date

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**DECLARATION OF DR. DAVID MORELAND IN SUPPORT OF
PETITION FOR RETROACTIVE LICENSE UNDER 37 C.F.R. § 5.25**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Petitioner, Dr. David Moreland, represents that he is the European Patent Attorney responsible for filing U.K. Application No. GB 0101014.9 (filed January 15, 2001) and PCT Application No. PCT/GB02/00178 (filed January 15, 2002). Although I am somewhat familiar with U.S. law, I did not realize that a U.S. foreign filing license was needed at the time the UK and PCT applications were filed, and thus these applications were filed without first obtaining a license under 37 C.F.R. § 5.11.

In early March, 2004, I instructed Allan Fanucci, the attorney of record for this case, to file a corresponding U.S. patent application in the U.S. Patent and Trademark Office. Soon after the U.S. Application was filed, Mr. Fanucci wrote to me, noting that one of the inventors had a U.S. residence address and asking me to confirm whether this inventor's contribution to the invention was made in the United States. A copy of his March 24, 2004 letter is attached hereto. This was the first time I realized that such a license might be required for those applications.

After receipt of Mr. Fanucci's letter, I attempted to ascertain whether or not Roy Powell's contributions to the invention were made in the United States. It appeared that at least some of his contributions may have been made in the United States, and based on that information, I instructed Mr. Fanucci to proceed with the filing of a retroactive request for a foreign filing license. As noted above, I was not aware of such a requirement at the time that the UK and PCT applications were filed, and I confirm that the U.K. and PCT applications were filed without first obtaining a license under 37 C.F.R. § 5.11 through error and without deceptive intent.

I further state that the subject matter in question from the British and PCT applications was not under a secrecy order at the time those applications were filed abroad in England, and that it is not currently under a secrecy order.

In view of the above remarks, it is also asserted that the submission of the petition for a retroactive foreign filing license under 37 C.F.R. §5.25 was and is being diligently sought after discovery of the error in the proscribed foreign filings.

I hereby declare that all statements made herein of my own knowledge, and that all statements made on information and belief, are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under Section 1001 of Title 18 of the United States Code, and that such willful statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully submitted,

Date

January 5, 2006

Dr. David Moreland

